

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

RYDEX, LTD.,

Plaintiff,

v.

FORD MOTOR COMPANY, et al.,

Defendants.

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CIVIL ACTION NO: 4:11-CV-00122

JURY TRIAL DEMANDED

**DEFENDANTS' MOTION FOR LEAVE TO SUPPLEMENT
THE EVIDENTIARY RECORD FOR *MARKMAN***

Additional compelling evidence has recently come to light regarding the impropriety of Plaintiff Rydex, Ltd.'s ("Rydex") added dependent claims under 35 U.S.C. § 305 during reexamination of U.S. Patent No. 5,204,819 ("the '819 patent"), which the Court is currently considering as part of the *Markman* proceedings in this case.¹ Despite their efforts to obtain this evidence long ago, Defendants could not have submitted this evidence to the Court prior to the *Markman* hearing in this case, as set forth below. Accordingly, Defendants respectfully request permission from the Court to file the accompanying supplement to the *Markman* evidentiary record. *See* Ex. A, Defendants' Supplement.

The additional evidence comes from the recent deposition of Edmund J. Sease, former litigation counsel to Rydex, which took place on September 25, 2012 and for

¹ As set forth in Exhibit A, this additional evidence further confirms that claims 39 and 40 of the '819 patent were improperly added during reexamination: i) to provide enlarging coverage not provided in the claims as originally filed, ii) in contemplation of litigation, and iii) without consideration of the prior art to be disclosed in the reexamination.

which the transcript was released on October 15, 2012.² While Mr. Sease had originally been served with a subpoena in this matter issued on January 25, 2012 (*see* Ex. B, Subpoena), Mr. Sease initially suggested that he had no involvement in the prosecution of the '819 patent (including its reexamination) and resisted the deposition from occurring. *See* Ex. C, Docket, Case No. 4:12-mc-00013-TJS (S.D. Iowa); Ex. D, Order. Mr. Sease's resistance necessitated protracted motion practice in the U.S. District Court for the Southern District of Iowa. *Id.* This motion practice included responding to a motion to quash, participating in a hearing before the Court in Iowa, and filing a motion to enlarge the scope of Mr. Sease's deposition and document production to include '819 patent prosecution topics such as reexamination. *See id.*; *see also* Ex. E, Resistance to Motion to Quash and Motion for Enlargement. Once the Iowa court ordered his deposition, Mr. Sease agreed to a deposition date of August 15, 2012 in his Des Moines, Iowa office. But due to unexpected health issues, Mr. Sease requested that his deposition be postponed to September 25, 2012. Defendants took his deposition on that date and the transcript was released on October 15, 2012. Defendants, therefore, had been unable to previously obtain and submit this evidence to the Court.

Pursuant to L.R. 7.1, Defendants have conferred with counsel for Rydex, who indicated that Rydex does not oppose inclusion of the Sease transcript in the record but nonetheless opposes Defendants' proposed submission (Ex. A).

For the reasons set forth above, Defendants respectfully request leave from the Court to file the accompanying supplement to the evidentiary record for the *Markman* proceedings in this case. A proposed order is attached hereto as Exhibit F.

² Rydex would not be prejudiced by this supplementation because its counsel participated in the deposition and had the opportunity to question Mr. Sease.

Dated: November 5, 2012

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5.3 on November 5, 2012.

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